

## REMARKS

Claims 1-24 stand rejected in the subject patent application. Claims 11-13 and 22 are being cancelled, and claims 25-31 are being added. Therefore, claims 1-10,14-21 and 23-31 will be pending after entry of this amendment.

Many claims have been amended to correct the misspelling of the word “indicia”.

### Rejection Under 35 U.S.C. §112

Claim 7 was rejected under the second paragraph of 35 U.S.C. §112. In response, the preamble has been amended to clarify that the building has a plurality of building elements. Furthermore, step (a) now clearly states that both a portable computer and an input device connected to the portable computer are provided at the building.

The rejection also asks, “Is the estimating cost of a damaged building is the total cost of a damaged building that would include regular elements?” Applicants are uncertain what is meant by “regular elements”, because that term does not appear in the claim nor elsewhere in the application. However, the claim expressly recites that the input device is used repeatedly to produce signals indicating a plurality of building elements that are damaged and the portable computer utilizes that each signal to access the data table and obtain the cost of each such building element. Therefore, the steps of claim 7 clearly define how the cost of damage is determined.

The rejection further contends that it is unclear how the total cost is calculated as “there is no summing step.” Claim 7 calls for the portable computer employing the cost of each given building element that is damaged to calculate a total cost of damage to the building. That step may include summing and other arithmetic operations involved in that

calculation. The Office Action really is objecting to the breadth of the claims, which is not to be equated with indefiniteness, *In re Miller*, 441 F.2d 689, 169 U.S.P.Q. 597 (CCPA 1971). Similarly the comment about whether the building elements refers to “materials or damaged elements” is not understood as the claim never mentions “materials”. Instead claim 7 refers to “a given building element” that is damaged.

Applicants submit that amended claim 7 complies with the requirements of the second paragraph of 35 U.S.C. §112 and request withdrawal of the rejection there under.

### **Rejection Under 35 U.S.C. §103**

Claims 1-6 were rejected under 35 U.S.C. §103 as being unpatentable over Durst *et al.* in view of Thompson *et al.*

The rejection contends that Durst *et al.* discloses the claimed elements of a medium, a data input device and a portable computer. However, Durst *et al.* describes a generic client computer 20 that is capable of utilizing machine readable or human readable codes to access networked data resources. Nowhere does this reference specify the use of such an apparatus for assessing construction work for a building. Durst *et al.* also does not teach a medium that displays a plurality of indicia representing different building elements, or a storage device that contains a table related to building elements and the costs thereof as in claim 2. Nor does that prior patent suggest the subject matter of claims 3-5.

For those missing elements, the rejection relies on the Thompson *et al.* patent. Although this latter reference teaches a computer system for construction job estimation, it still does not teach a medium for displaying a plurality of indicia representing different building elements and a data input device for selecting one of those plurality of indicia.

Instead, the computer system presents a display shown in Figure 3 that has a first column containing questions to which the user types in answers in an adjacent second column 12. Thus, the referenced system requires that the user type alphanumeric text into the computer keyboard and does not display indicia representing different building elements from which the user selects using an input device. Note that the icons across the top of the screen in Thompson *et al.*'s Figure 3 are not building elements (column 9, lines 50-55) and thus do not correspond to the indicia recited in claim 1.

As a result, the combined teachings of Durst *et al.* and Thompson *et al.* does not teach a medium that displays a plurality of indicia, each of which represents one of the building elements that then are selected by a data input device. Therefore, the fundamental system recited in claim 1 is not suggested by the references.

Furthermore, dependent claims 3-5 recite specific features that also are not suggested by the references, either alone or in combination. Specifically, claim 3 states that each of the plurality of indicia encodes a number that is used by the portable computer to select a cost contained in the data table. As stated previously, Durst *et al.* does not disclose such indicia, and the list of questions and even the graphical symbols presented on the Thompson *et al.* display do not encode a number. The Office Action's citation to a numerical value in a passage of the Thompson *et al.* patent does not refer to indicia that is displayed to the user as encoding a numerical value. Claims 4 and 5 state that the input device is a barcode reader and the plurality of indicia are barcodes. Although the Durst *et al.* computer system may include a barcode reader, the combination of references fails to suggest using barcodes as indicia that represent building elements. As a consequence, claims 3-5 are not rendered obvious by the cited references.

Claims 7-19 and 21-24 were rejected under 35 U.S.C. §103 as being unpatentable over Durst *et al.* in view of Thompson *et al.* and further in view of Borghesi *et al.*

Claims 7-19 relate to a method for estimating cost of damage to a building. Claim 7 has been amended to specify that the input device scans a graphical indicium to designate the given building element that has been damaged. None of the patents cited with respect to that claim teaches such scanning. At best, Durst *et al.* generically describes inputting generic data into a computer with a barcode reader. However, neither patent goes so far as to suggest how to use an input device to scan indicia to designate a damaged building element, or where such indicia is obtained. In contrast, the references describe how text is entered into forms that are displayed on a computer monitor to designate building components in Thompson *et al.* or motor vehicle parts in Borghesi *et al.* Therefore, even when the teachings of all three references are combined, nothing teaches the indicia scanning by an input device as recited in amended claim 7.

The combined teachings of the references also fails to suggest providing a medium that displays a plurality of graphical indicia that are then scanned as specified in claim 8 or in particular where such indicia are barcodes as stated in claim 9.

Claims 16 and 17 specify that information regarding the damaged building elements is organized by areas of the building in which those elements are located. Here too, none of the patents cited against these claims teaches such information organization.

Claim 21 has been amended to state providing a non-electronic medium that displays a plurality of indicia, each representing one of the plurality of building elements. This claim also specifies that the input device reads one of those indicia to produce the signal designating a given building element. As noted above, none of the references discloses a

non-electronic medium that displays a plurality of indicia that represent different building elements. At best, the Office Action may have shown that the reference computers have an electronic display on which different building elements are designated. However, that electronic display does not suggest the presently claimed non-electronic medium, such as the sheets on which barcodes are printed in Figure 3 of the present application, for example. As noted above, although the references mention that a barcode reader can be used for data input, that does not suggest where one would obtain a non-electronic medium with the indicia that designate building elements. Any contention otherwise is clearly based on the hindsight acquired from the teaching in the present application. Therefore, the corresponding steps of the method in claims 21-24 have not been shown to be obvious.

As a consequence, the Office Action has failed to establish a *prima facie* case that claims 7-19 and 21-24 are unpatentable under 35 U.S.C. §103.

Claims 12-13 have been rejected under 35 U.S.C. §103 as being unpatentable over Durst *et al.*, Thompson *et al.* and Borghesi *et al.* and further in view of Skinner. This rejection has been rendered moot by the cancellation of these claims.

### **The New Claims**

New claims 25-28 depend from claim 1.

Claim 25 specifies that the medium containing the indicia is non-electronic, while claim 26 states that the medium comprises a sheet of material. As discussed above with respect to claims 21-24, none of the cited patents suggests these types of media.

Claim 27 recites that the portable computer has an alphanumeric display, such as element 12 in Figure 1 of the application. This display is separate and distinct from the

medium that contains the plurality of indicia in claim 1 and the cited patents do not suggest both a alphanumeric display device and a separate medium that displays the indicia.

Claim 28 specifies that the input device reads the plurality of indicia and such reading is not performed by any mechanism in the patents cited in the office action.

Claim 29 states that depreciation is factored into the calculation of the total cost of building damage, as described beginning on page 12, line 21 in the application. None of the cited patents factors depreciation into damage cost estimates.

Claim 30 states that cost of labor is included in the cost of the given building element, as described as part of damage estimation (see page 2, lines 9-12 and the last two items in the table of Figure 4 in the application). The prior patents do not suggest including labor costs in the cost of each damaged element.


Therefore, the new claims 25-31 are patentable.

## Conclusion

In view of these distinctions between the subject matter of the present claims and teachings of the cited patents, reconsideration and allowance of the present application are requested.

Respectfully submitted,  
Larry L. Stein, *et al.*

Dated: January 10, 2005

By:   
George E. Haas  
Registration No. 27,642

Quarles & Brady LLP  
411 E. Wisconsin Avenue Suite 2040  
Milwaukee, WI 53202-4497

Telephone (414) 277-5751

Q&BMKE5679524.1